

Group III, directed to Claims 33-48, 77-90, drawn to a method for quantifying an oxidizing enzyme, classified in class 432, subclass 25.

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group I, Claims 1-16 and 49-62, and reserve the right to file a divisional application directed to the non-elected subject matter of the remaining claims in this application.

However, Applicants respectfully traverse the present restriction requirement and request reconsideration of this restriction requirement in view of the following remarks.

It was previously held that claims sharing common subject matter which merely provide additional limitations to perfect the basic inventive concept are therefore so interwoven as to constitute a single invention to be examined together. See, In re Application of Leber, Decision on Petition, filed July 20, 1987, Serial No. 902,864, published in PRI opinions on December 3, 1990; a copy of which is attached herein. In the present case, all the claims of the present invention clearly share common subject matter. In the first instance, Groups I and II are in the same class, class 435. Furthermore, Group I and III are in the same subclass (25). Thus, the claims in these groups be examined together. But even more importantly, all of the claims should be examined together since all of the claims are directed to a method, relating to detecting an enzyme or enzymes by determining the presence or absence of oxidative reactions catalyzed by at least one enzyme in a solution, wherein this method utilizes a luminescence detection system which is a fluorescence detection system wherein the fluorescing sensor compound is one which exhibits a quantifiable degree of quenching when exposed oxygen. This is method comprising:

- (i) contacting said solution with a sensor composition which comprises a luminescent compound that exhibits a change in luminescent property, when irradiated with light containing wavelengths which cause said compound to luminesce, upon exposure to oxygen, wherein the presence of the sensor composition is non-destructive to the enzyme(s);
- (ii) irradiating said sensor composition with light containing wavelengths which cause said luminescent compound to luminesce;

- (iii) measuring or visually observing the luminescent light intensity from said luminescent compound while irradiating said sensor compound with said light; and
- (iv) comparing said measurement to that of a control not containing enzyme(s) capable of catalyzing oxidative reactions, wherein said control is selected from the group consisting of: a reagent control not in contact with said enzyme(s) and a calculated threshold, wherein a change in luminescent property relative to the luminescent property of the control is indicative of the presence of said enzyme(s); and
- (v) in the event that no such increase is measured or observed, repeat steps (ii), (iii) and (iv) as needed, to determine the presence or absence of said enzyme(s) in said solution.

There are additional limitations in independent Claims 18, 35, 52, 67 and 82 (i.e., in Claim 17, the solution is a reaction mixture of enzymes which is admixed with a drug, toxin or chemical in Claim 17, step (iii) [just before step (ii) above], and in independent Claim 49, step (i) the sensor composition is placed within a container but not in direct contact with the fluid or solution which has been substantially isolated from atmospheric oxygen). However, as stated above, these are merely additional limitations to perfect the basic inventive concept. The base methodology is common to every one of Claims 1-90.

Accordingly, Applicants respectfully submit that all of the claims share common subject matter, and thus Applicants respectfully request that the present restriction requirement should be withdrawn.

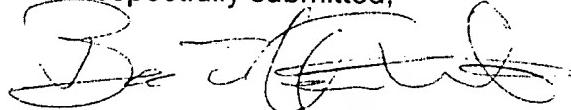
It should also be observed that a requirement for restriction is not mandatory under either 35 U.S.C. §121 or 37 C.F.R. §1.142, it is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 USPQ 98 (E.D. Va. 1966), aff'd, 374 F. 2d 511, 153 USPQ 91 (4th Cir. 1967). In addition, the courts have recognized the advantages to the public interest to permit a patentee to claim all aspects of its invention, as the Applicants have done herein, so as to encourage the patentee to make a more detailed disclosure of all aspects of its discovery. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in a manner required by 35 U.S.C. §113 all aspects of what they regard as their invention; regardless of the number of statutory classes involved. *In re Kuehl*, 177 USPQ 250, 256 (CCPA 1973). (Emphasis added).

Furthermore, Applicants respectfully suggest that in view of the continued increases of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional intent to promote and encourage the progress of science and the useful arts.

Thus, it is again respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,



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